

Remarks

Applicants, through their attorney, respectfully request the Examiner to reconsider and withdraw the outstanding rejections of the claims for the reasons set forth below.

The Examiner rejected claims 1, 2 and 11-22 under 35 U.S.C. § 112 for lack of enablement. In addition the Examiner rejected claims 1, 2 and 5-22 under 35 U.S.C. § 112 for indefiniteness. Applicants have amended independent claim 1 to address the antecedent basis issue in regards the “*the* lubricating oil”.

Applicants have also amended claim 1 to add limitations to the materials that can be used for components A, B and C. Support for this amendment is found on page 4, lines 25-30 and page 5, lines 1-17, 25-31 of the specification. These limitations were used in claims 5, 6 and 7, which are not currently rejected for lack of enablement, and correspond to the limitations used in claim 25, which is not currently rejected under any paragraph of 35 U.S.C. § 112. Corresponding amendments were also made to now independent claim 11. These amendments address the lack of enablement and indefiniteness issues raised by the Examiner and therefore, these rejections should be removed.

As a result of the amendments described above, applicants have amended claims 5, 6 and 7, removing the limitations now present in claim 1, on which all of these claims depend, and retaining the formulation ranges of the various components in the claimed composition. Further, Applicants have amended the claims so that they are in proper format. Finally, applicants have amended a typographical error in claim 9. The acronym for total base number was inadvertently listed in the claim as “TNB”. This error has been corrected and the acronym is now correctly listed as “TBN”.

The Examiner rejected claims 1, 2, 5-10 and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Higton, et. al., (6,310,010). The Examiner maintains the position that Higton meets the limitations of the claims when the dispersant, detergent and antioxidant combination in a package forms a gel and that although reducing the emissions is not taught by Higton, it is inherent because Higton teaches that gels are suitable for use in lubricants for gasoline and diesel engines. Applicants respectfully disagree.

Furthermore, the Examiner stated that the declaration filed with the preliminary amendment stated that the gel compositions are solid-like, non-liquid materials. The Examiner notes that this language has not been included in the claims. The Examiner is of the position that gels include a colloidal solution of liquid in a solid.

Amendment and Remarks

Applicants have amended independent claims 1, 23, and 24 by adding the limitation that the gels referred to in the claims are “semi-solids”, that is non-liquid, solid-like materials as described in the declaration. Support for this amendment is found on page 6, lines 4-16 of the specification. This additional limitation provides a clear distinction between the solid-like gels claimed by Applicants and the liquid concentrates taught by Higton.

Accordingly Applicants claims semi-solid gels are not described, suggested nor taught by Higton. Therefore applicants’ invention is novel and unobvious over the reference and the rejections should be removed.

The Examiner noted that claims 11-22 would be allowable over Higton if rewritten in independent form, as they were objected to only as being dependent upon a rejected base claim. In addition to the amendments described above, applicants have amended claims 11, 21 and 22, placing them in independent form. Support for these amendments is found on page 4, lines 25-30 and page 5, lines 1-17, 25-31 of the specification.

For the reasons set forth above, Applicants' present invention as claimed is novel and not obvious over the reference. Applicants respectfully request the Examiner to remove the 35 USC 103(a) rejections and find all claims allowable.

If any fees are due, the Commissioner is authorized to charge such fee to The Lubrizol Corporation Deposit Account No. 12-2275. A duplicate copy of this document is submitted for such purposes.

Respectfully submitted,
THE LUBRIZOL CORPORATION

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